



REMARKS

Claims 21, 28-33 and 35-49 were pending and under consideration. Applicants Amendment, mailed January 21, 2003, was not entered. With this amendment, Claims 31, 38-45 and 48-49 are canceled without prejudice. Claim 21 has been amended. After entry of the instant amendment, Claims 21, 28-30, 32-33, 35-37 and 46-47 are pending and under consideration. A version with markings to show changes made is attached at Exhibit A. For convenience, a clean copy of the pending claims after entry of the instant amendment is attached at Exhibit B.

I. THE AMENDMENT TO THE CLAIM

Claim 21 has been amended to recite, in relevant part, a method for identifying the presence of cancerous cells in a human sample using a pair of primers, wherein said pair of primers consists of a first primer which hybridizes within exon 8 of the hTERT gene and a second primer which hybridizes upstream of exon 7 or downstream of exon 8 of the hTERT gene. Support for amended Claim 21 can be found, for example, in Claim 21 as originally filed. Support for amended Claim 21 can also be found, for example, in the specification at page 15, line 29 to page 16, line 20, as acknowledged by the PTO, in the final Office Action mailed December 12, 2002, page 2.

As the amendment is fully supported by the specification and claims as originally filed, it does not constitute new matter. Applicants believe amended Claim 21 places the Claim in condition for allowance. Applicants hereby request entry of the amendment into the record.

II. 35 U.S.C. §112, FIRST PARAGRAPH

Claims 21, 28-33 and 35-49 stand rejected allegedly as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The PTO states that the specification allegedly does not describe or discuss a second primer that "hybridizes within, upstream or downstream of exon 8 of the hTERT" (Office Action mailed December 9, 2002, page 2).

Applicants submit that Claims 38-45 and 48-49 are fully supported by the specification, however merely to place the claims in condition for allowance, Applicants have canceled Claims 38-45 and 48-49 without prejudice. Therefore the rejection of Claims 38-45

and 48-49 is rendered moot. Claim 21 has been amended to recite, in relevant part, a method for identifying the presence of cancerous cells in a human sample using a pair of primers, wherein said pair of primers consists of a first primer which hybridizes within exon 8 of the hTERT gene and a second primer which hybridizes upstream of exon 7 or downstream of exon 8 of the hTERT gene. Support for amended Claim 21 can be found, for example, in Claim 21 as originally filed. Support for amended Claim 21 can also be found, for example, in the specification at page 15, line 29 to page 16, line 20, as acknowledged by the PTO, in the final Office Action mailed December 12, 2002, page 2.

Applicants submit that Claims 21, 28-30, 32-33, 35-37 and 46-47 are fully supported by the specification and do not introduce new matter. Applicants respectfully request that the rejection under 35 U.S.C. §112, first paragraph be withdrawn.

III. 35 U.S.C. §103

Claims 38-45 and 48-49 stand rejected under 35 U.S.C. §103 as allegedly being unpatentable over Kilian (Human Molecular Genetics, 2011-2019) in view of Nakamura (Genbank Accession Number AF015950) in further view of Stratagene Catalog (1988). Applicants respectfully disagree and submit that Claims 38-45 and 48-49 are not obvious. However, merely to expedite prosecution Applicants hereby cancel Claims 38-45 and 48-49 without prejudice rendering rejection of these claims moot. Applicants respectfully request that the rejection under 35 U.S.C. §103 be withdrawn.



CONCLUSION

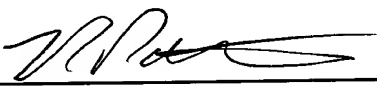
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Applicants thank the Examiner for courtesies extended in recent telephone conversations and submit that Claims 21, 28-30, 32-33, 35-37 and 46-47 satisfy all of the criteria for patentability and are in condition for allowance. An early indication of the same and passage of Claims 21, 28-30, 32-33, 35-37 and 46-47 to issuance is therefore kindly solicited.

No fee is believed due in connection with this response. However, the Commissioner is authorized to charge all required fees, fees under 37 CFR § 1.17 and all required extension of time fees, or credit any overpayment, to Pennie & Edmonds LLP U.S. Deposit Account No. 16-1150 (Order No. 1803-298-999).

Respectfully submitted,

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EXHIBIT A

Claim Amendment: Version with Markings to Show Changes Made

21. (Thrice amended) A method for identifying the presence of cancerous cells in a human sample wherein said method comprises:
- (a) determining the quantity of hTERT mRNA comprising β -region coding sequence in said sample and in a control sample of non cancerous cells by:
- (1) contacting RNA from said sample and said control sample with a pair of primers, wherein said pair of primers consists of a first primer which hybridizes within exon 8 of the hTERT gene and a second primer which hybridizes [within,] upstream of exon 7 or downstream of exon 8 of the hTERT gene;
 - (2) amplifying the nucleic acid sequence;
 - (3) measuring the generation of amplification products;
 - (4) determining the quantity of hTERT mRNA comprising β -region coding sequence in said sample from the results obtained in step (3); and
- (b) identifying the presence of cancerous cells in said sample if the quantity of hTERT mRNA comprising β -region coding sequence in said sample is greater than the quantity of hTERT mRNA comprising β -region coding sequence in said control sample.